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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/783,078

02/20/2004

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11/14/2007

EXAMINER

GEORGE, KONATA M

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

11/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/783,078

Applicant(s)

DIHEL ET AL.

Examiner

Konata M. George

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-13 are pending in this application.

Action Summary

1. The rejection of claim 1 under 35 U.S.C. 112, second paragraph, as being indefinite is hereby withdrawn as applicant has amended the claim.
2. The rejection of claims 1-13 under 35 U.S.C. 103(a) as being unpatentable over Leung et al. is being maintained for the reasons stated in the office action dated May 24, 2007.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 1616

3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leung et al. (US 7,025,983).

Determination of the scope and content of the prior art

(MPEP §2141.01)

Leung et al. teach dissolvable films comprising water-soluble film forming polymers such as pullulan (abstract). Column 4, line 66 through column 5, line 14 teach other film-forming agents such as hydroxypropylated starches. Leung et al. disclose in column 6, lines 21-54 and column 7, lines 8-47, examples of sweeteners and flavoring agents that can be used in the film. Leung et al. disclose in column 11, lines 45-61 a method of making a dissolvable film comprising mixing the film-forming ingredients and aqueous mixture to form a polymer gel, adding the oil mixture (substrate) to the gel and drying the mixture to form a film.

Ascertainment of the difference between the prior art and the claims

(MPEP §2141.02)

Leung et al. do not teach the substance being encapsulated.

Finding of prima facie obviousness

Rational and Motivation (MPEP §2142-2143)

Applicant recites in claim 6 that that encapsulated substance is a volatile substance. A volatile substance is a substance that vaporizes or evaporates quickly.

Art Unit: 1616

Since the claimed substance is volatile, it would have been obvious to one of ordinary skill in the art at the time the invention was made to encapsulate a volatile substance for the purpose of reducing the evaporation of the substance. Reducing the evaporation would allow the substance to be used at maximum strength for its intended purpose.

Response to Arguments

4. Applicant's arguments filed August 24, 2007 have been fully considered but they are not persuasive.

Applicant argues that the prior art reference of Leung et al. do not teach the claimed invention, especially adding the substance onto the film after the film is made. It is also argued that the substance of Leung et al. is not encapsulated. It is the position of the examiner that although the prior art does not teach encapsulating the substance or adding the substance to the film after the film is made it would have been obvious. Encapsulating of substances is well known through out the pharmaceutical world, for various reasons, such as, delaying the release of a substance or protecting the substance from an unfavorable condition. This reasoning could lead one of ordinary skill in the art of making dissolvable films to coat the substance. They would want to delay the release of the substance until it reached the optimum conditions. Applying the substance onto the film would have been obvious for a few reasons. One reason is that adding the substance after mixing the film forming ingredients maintains the integrity of the substance. Another reason is that adding the substance after the film is made

allows one of ordinary skill to ensure that the appropriate amount of substance is applied to the film to achieve the desired results of the substance.

Conclusion

5. Claims 1-13 remain rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Telephone Inquiries

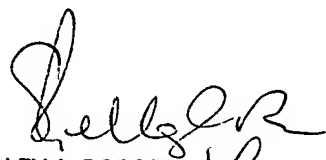
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8:00AM to 6:30PM Monday to Thursday.

Art Unit: 1616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reached at 571-272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Konata M. George
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SHELLEY A. DODSON
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